without comment. The Federal Circuit also denied Nystrom's Motion to Stay Mandate without comment.

## III. ARGUMENT

For the reasons discussed below, the Court should deny certiorari of the present petition.

### A. This Petition Does Not Present an Appropriate Case for Certiorari

Trex respectfully submits that this case does not merit this Court's attention. It does not present an appropriate vehicle for reviewing any of the Questions Presented for two reasons. First, the issue of deference to district court findings was neither presented nor preserved below. Second, it would be an advisory exercise, having no impact on the outcome of this case.

#### 1. The Issue of Deference to a District Court's Alleged Factual Findings on Claim Construction Was Neither Argued Nor Decided Below

This Court ordinarily will "not decide in the first instance issues not decided below." *National Collegiate Athletic Ass'n v. Smith*, 525 U.S. 459, 470 (1999). This Court considers questions "not pressed or passed upon below" only in unusual circumstances. *See, e.g., United States v. Williams*, 504 U.S. 36, 41 (1992). The question presented by the petition was never argued nor decided below. Nor has Petitioner demonstrated exceptional circumstances that would justify departing from this general rule.

Petitioner never suggested to the Federal Circuit that it should defer to the district court's claim construction until the merits of the appeal were essentially decided. Nor would it reasonably have made this argument; the district court had ruled against Petitioner. Nystrom has, from the start of the appeal, argued that claim construction is reviewed *de novo*. In his opening brief, Nystrom stated that: "Claim construction is a question of law that this Court reviews de novo. No deference is given to the district court's construction." (Opening Brief at 17 (citations omitted)). Respondent, Trex, agreed that claim construction is reviewed *de novo*. The Federal Circuit below did review the claim construction *de novo* and never decided the issue. The first Question Presented, therefore, was neither presented nor decided below. The Federal Circuit had no opportunity to address this issue in the context of this case. *See Illinois v. Gates*, 462 U.S. 213, 222-23 (1983) ("[T]he routine restatement and application of settled law by an appellate court did not satisfy the 'not pressed or passed upon below' rule.").

Petitioner maintained his position that review should be *de novo*, until he was unsuccessful on appeal. It was not until after receiving the adverse September 14, 2005 decision that Nystrom first raised this issue. Nystrom first raised this alleged issue in his petition for rehearing and rehearing *en banc* of the Federal Circuit's September 14, 2005 decision and raised it again in his Motion to Stay Mandate. Both were denied.

The petition on the first question should be denied at least for these reasons.

### 2. Deference to the District Court Will Not Affect the Outcome

Petitioner argues, at page 19 of his petition, that the Federal Circuit should have deferred to the district court's alleged factual findings in this case. Petitioner makes two arguments in this regard: Rule 52 somehow compels it; and this Court's authority demands it.

First, Rule 52 specifies a heightened standard of review only for the district court's factual findings:

> Findings of fact, whether based on oral or documentary evidence, shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.

Fed. R. Civ. P. 52(a). In arguing that this provision governs claim construction, Petitioner relies heavily on Judge Mayer's dissenting opinion in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1330 (Fed. Cir. 2005) (Mayer, J., dissenting), concerning the deference that should be given to alleged factual findings that underlie a district courts' claim construction order. Whether or not Judge Mayer has a point in *Phillips*, there were no fact findings in this case. Judge Mayer joined the panel majority in this case, resulting in a unanimous September 14, 2005 decision. The Federal Circuit did not fail to defer to any factual findings in the district court in this case. In fact, the Federal Circuit affirmed the district court's decision on claim construction and infringement.

Second, even were this Court to assume, for sake of argument, that there was some unidentified factual finding to

which deference should have been given, this is not the appropriate case in which to review this issue. In this case the Federal Circuit affirmed the district court's construction. Having affirmed it without giving any deference, it would have likewise affirmed had deference been given. The outcome of the present case does not depend, in any manner, on the level of deference, if any, given to the district court's alleged factual findings.

Petitioner does not even identify what factual findings he contends the district court made, let alone which the Federal Circuit should have deferred to. This omission is critical. Petitioner has failed to identify any underlying factual findings by the district court.

In its *en banc* decision in *Phillips*, the Federal Circuit expressly declined to rule on this issue, whether there were any factual underpinnings to claim construction, stating "[a]fter consideration of the matter, we have decided not to address that issue *at this time*." 415 F.3d at 1328 (emphasis added). The Federal Circuit, therefore, may review and address the issue of *de novo* review when the proper case comes before it. This Court should also have the benefit of the Federal Circuit's views on this subject if it chooses to address it in the proper case.

### B. The Federal Circuit Panel Decision is Consistent with Federal Circuit and This Court's Precedent

It is undisputed that the district court's claim construction in this case is based on the intrinsic evidence. Even then-Chief Circuit Judge Mayer declared that no deference is due where a district court's claim construction depends solely on intrinsic evidence. In his concurrence in

*Cybor*, for example, Judge Mayer explained that where no facts were disputed below, there would be no reason to defer to the trial court's claim construction:

> Provided that no factual findings about disputed terms were necessarily made in the course of construing the claim, our making a claim construction that supersedes that of the district court is not inconsistent with the [Supreme] Courts' opinion [in Markman].

*Cybor Corp. v. FAS Techs.*, 138 F.3d 1448, 1465 (Fed. Cir. 1998) (*en banc*) (Mayer, J., dissenting).

Similarly, even Judge Mayer's dissent in *Phillips* does not contend that every claim construction decision requires deference to the district court's factual findings. In some cases, a district court may be "required to sift through and weigh volumes of evidence" such as "experts offering conflicting evidence" or "contradictory dictionary definitions." *Phillips*, 415 F.3d at 1332. Those orders, where competing claim constructions are "hotly contested by the parties, not by resort to case law as one would expect for legal issues, but based on testimony and documentary evidence," are the ones that, in Judge Mayer's view, are owed deference. *Id.*

The district court in this case, however, never relied on any expert testimony or extrinsic documentary evidence. The district court's claim construction in this case would have received no deference even under the alternative regime Judge Mayer proposes. Moreover, Judge Mayer himself joined the unanimous panel decision this Petitioner seeks to review in this case.

Petitioner argues that the Federal Circuit's decision also conflicts with this Court's precedent in *Markman and Dennison.* Yet, *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809 (1986) involved obviousness, not claim construction. Petitioner argues that this Court held in *Markman* that "claim construction involves fact-finding in the district court" (Petition at 18), yet, cites no portion of the Court's *Markman* decision that supports that assertion. Indeed, none does.

The Supreme Court in *Markman* expressly held that claim construction is an issue of law. *Markman*, 517 U.S. at 372 ("We hold that the construction of a patent, including terms of art within its claim, is exclusively within the province of the court."). As claim construction does not involve "fact finding" for the purposes of the Seventh Amendment, it does not logically involve "fact finding" by a judge. In the Federal Circuit decision that this Court reviewed in *Markman*, the Federal Circuit expressly held that appellate review of claim construction is *de novo. Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996). The Supreme Court affirmed. The *en banc* Federal Circuit in *Cybor* reached the same conclusion, holding that claim construction, "as a purely legal issue, is subject to *de novo* review on appeal." *Cybor*, 138 F.3d at 1451. There is no conflict within the Federal Circuit or with this Court's prior decisions.

Petitioner paints a tortuous story of the history of claim construction law, yet, never identifies any Supreme Court precedent that conflicts with the Federal Circuit's *en banc* decisions in *Phillips* or case. The Federal Circuit's decision this case is in accord with this Court's precedent

looking to the specification and prosecution history in construing claim terms. *Markman*, 517 U.S. at 389-390.

Petitioner repeatedly overstates his argument that the Federal Circuit's "current claim construction methodology" confines the claim meaning to "the particulars of the inventor's preferred embodiment described in the specification." (Petition at 23, 19-20, 11.) That is not what happened in *Phillips* and it is not what happened in this case. Nystrom's preferred embodiment is far more limited than the Federal Circuit's construction of the term "board" as a "piece of elongated construction material made from wood cut from a log." (App. 9A, 16A.) Nystrom's specification states that "in a preferred construction the board also has a complementary shaped concave bottom surface 14 with a radius of curvature $R_2$ of about 24 inches." (U.S. Patent No. 5,474,831, col. 3, ll. 15-17.) The specification discloses additional details of the preferred embodiment, such as the "curvature of the top surface in the same general direction as the curvature of growth rings." (*Id.*, col. 3, ll. 26-27.) Contrary to Nystrom's arguments, the Federal Circuit did not construe the claims to be limited to the particular specification of Nystrom's preferred embodiment. Nor does the methodology of *Phillips* result in patents being improperly limited to the preferred embodiment.

Contrary to Nystrom's attempt to divorce the claim language from the intrinsic evidence, *Phillips* and the Federal Circuit panel's decision in this case follow the well-established precedent that the specification and prosecution history play an important role in construing the claims. "[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." *Vitronics*, 90 F.3d at 1582. "The construction that stays true

to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction." (App. 10A, quoting *Phillips*, 415 F.3d at 1316.) *Phillips* did not change this long-established precedent, it properly limited the excesses of determining ordinary meaning based solely on extrinsic references, such as dictionaries, and looking to the specification and prosecution history only for clear disavowal or express disclaimer of that broader scope. *Phillips*, 415 F.3d at 1320-21.

As this Court held in 1996 in *Markman*, a claim term can be defined only in "a way that comports with the instrument as a whole," 517 U.S. at 389, so that the definition "fully comports with the specification and claims and so will preserve the patent's internal coherence" (*Id.* at 390). The definition of "board" set forth by the Federal Circuit here is consistent with the scope and content of the Nystrom patent as a whole, and preserves its "internal coherence."

## IV. CONCLUSION

Respondent, Trex, respectfully submits that the petition should be denied. Review of the Federal Circuit panel's decision would waste this Court's and the parties' time and have no effect on the decision below. The panel's decision is entirely consistent with this Court's precedent.

Respectfully submitted,

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